REMARKS

The non-final Office Action, mailed April 17, 2007, considered claims 1-22 and 24-26. Claims 12 and 13 were objected to for minor informalities which have been corrected by this amendment. Claims 1-22 and 24-26 were also rejected. In particular, claims 1-10, 12-22, 24 and 25 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1, 2, 4-7, 11-14, 16-19, 23 and 24 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Andersson* (U.S. Patent No. 6,047,194). Claims 3 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Andersson* (U.S. Patent No. 6,047,194) in view of *Wang* (U.S. Patent No. 6,614,774). Claims 8, 9, 20 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Andersson* (U.S. Patent No. 6,047,194) in view of *Brothers* (U.S. Patent No. 6,822,955).[1]

By this paper, claims 1, 10, 13, 22 and 26 have been amended, claims 11 and 12 cancelled, and claims 27 and 28 added. Accordingly, following this paper, claims 1-22 and 24-26 remain pending, of which claims 1, 10, 13, 22 and 26-28 are the only independent claims at issue.

Initially, Applicant notes that the remarks and amendments presented herein have been made to merely clarify the claimed embodiments and to explicitly recite elements that Applicant believes were already inherently present in the claims. For example, claims 1 and 13 have been amended to clarify that originator of packet data transmits the desired data packets only after the wireless mobile communication station has determined that receipt of the packet data is desired. In addition, claims 1, 10, 13 and 22 have been amended to clarify that each step in the recited methods is actually performed by a computing element executing computer-executable components. Notably, inasmuch as each of claims 1, 10, 13 and 22 are method claims, they necessarily require performance of each element (i.e., a recitation of acts in a method claim necessarily requires execution of the various recited acts). Claims 27 and 28 have been added

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[1]   Although the prior art status of the cited art is not being challenged at this time, Applicant reserves the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

The Office Action also notes that a certified copy of Swedish Application No. 990363-7 and EPO Application No. 01850013.2 have not been filed in this case, or the parent U.S. Case (Application No. 09/684,057). Applicant respectfully disagrees. Upon a review of PAIR, a certified copy of the Swedish Application was filed in the parent case and received in the USPTO receiving office on December 28, 2000. Similarly, a certified copy of the EPO application was filed in the present case, and received in the USPTo receiving office on April 3, 2001.

but merely recite in full, independent form, claims corresponding to the now cancelled claims 11 and 12. Support for the claim amendments and new claims can be found in at least the disclosure provided by Figure 1, and in paragraphs 12, 14, 16, 21, 22, 40-44, 48 and 50-55 of the originally filed application.

As reflected in the above claims, the above claims are generally directed to methods, computer-readable storage media, and devices for transmitting packet data in a way that provides wireless device users to a mechanism to determine, real-time, which packet data to receive. As reflected in claim 1, for example, a wireless mobile communication station executes executable components causing the station to receive a network address of an originator of packet data, where the originator is attempting to push the packet data to the mobile communication station. The network address is received in a message from a message service in response to the originator submitting a request to the message service requesting that the message service transmit the message to the wireless mobile communication station containing the originator's network address. The wireless mobile communication station also acquires an identity corresponding to the received network address, and determines, based on the identity, whether or not packet data from the originator is desired. Only after determining that the packet data is desired, does the wireless mobile communication station establish a packet data session with the originator which enables the wireless mobile communication station to receive the desired packet data from the originator. Additionally, it is only after determining that the packet data is desired that the originator of the packet data transmits the data. In this manner, the wireless mobile communication station can selectively permit desired packet data to be pushed from the originator to the wireless mobile communication station.

Claims 13 recites a method generally corresponding to the method of claim 1; however, claim 13 is recited from the overall system perspective, and recites execution of discrete acts by each of the originator, wireless mobile communication station, and message service. Claim 27 recites a computer-readable storage medium having stored thereon computer-executable components that, when executed, cause the wireless mobile station to perform a method generally corresponding to the method of claim 1. Claim 28 recites a mobile communication station having processing means, memory means, interface circuitry means, and user interface means for performing a method generally corresponding to the method of claim 1.

I. Rejections under 35 U.S.C. § 102

Applicant respectfully submits that the claims, particularly as amended, define methods which are substantially different from the methods and systems of *Andersson*. For example, among other things, *Andersson* fails to disclose a method in which an originator of packet data transmits the desired packet data *only after* the wireless mobile communication station determines that the packet data is desired, as recited in combination with the other claim elements. Indeed, although *Andersson* does disclose that the wireless mobile device enters into packet mode and receives desired packet data only if it is determined that the mobile user wants to receive the packet data, it appears that *Andersson* that desired packet data is transmitted by the originator (i.e. Internet Host 12 or the Sending Station; *see also* Office Action, p. 9), regardless of whether the wireless mobile communication station decides to accept the packet data. In particular, the Internet Host or Sending Station which originates the packet data, transmits the packet data to the network infrastructure in the first instance, and then the information is finally forwarded on to the wireless device, if desired.

More particularly, *Andersson* discloses methods and systems in which a wireless station can select whether or not to permit transmission of packet data thereto. (Col. 7, ll. 8-10). In the disclosed methods and system, a "sequence" is followed in which various signals are generated to provide the user selective reception of only desired packets. (Col. 7, ll. 14-20). In that sequence, the data originated at the Internet Host is "first" routed from the Internet Host and to a gateway packet mobile switching center (GPMSC) within a public land mobile network (PLMN). (Col. 6, ll. 26-32; Col. 7, ll. 21-23; Figs. 1, 2). The packet data includes header information which identifies the wireless device for which the packet data is intended, and that information is used by the GPMSC to locate the mobile terminal. (Col. 7, ll. 23-36).

The GPMSC also encapsulates the packet data and forwards it to a visited location packet mobile switching center (VPMSC) which serves the mobile terminal. (Col. 7, ll. 36-41). The encapsulated data is then de-capsulated, and some of the packet data, including the source IP address, is forwarded to a short messaging center (SMS-C), which issues an SMS message that is ultimately routed to the mobile terminal. (Col. 7, ll. 41-64). A determination can then be made at the mobile terminal as to whether to accept transmission of packet data originated by the Internet Host identified in the SMS message. (Col. 8, ll. 3-6, 40-43). When permission is provided, the mobile terminal transmits such permission and enters into a packet state, and the

packet data is then routed to the mobile terminal by the PLMN. (Col. 6, ll. 11-13; Col. 8, ll. 7-13).

A similar, more broadly discussed, method is disclosed in *Andersson* in which a mobile station receives messages originated by a sending station, by using an intermediate network infrastructure. (Col. 8, ll. 44-50). Specifically, packet data originated by the sending station is first sent to the network infrastructure. (Col. 8, ll. 51-53). Thereafter, the identity of the sending station is determined and an SMS message is formed which identifies the sending station, and sent to the mobile receiving station. (Col. 8, ll. 53-58). Upon receipt of the SMS message, the mobile receiving station selects whether to accept transmission of the packet data originated by the sending station. (Col. 8, ll. 59-63). If permission is granted, the packet data is sent to the mobile receiving station. (Col. 8, ll. 63-65). In this manner, transmission of undesired or unsolicited packet data is selectively prevented by denying permission to transmit the packet data to the mobile device. (Col. 8, ln. 66 to Col. 9, ln. 5).

Accordingly, in each of the methods disclosed in *Andersson*, the first step is to transmit "packet data" from the sending station (e.g., Internet Host) to the network infrastructure (e.g., PLMN), the next-to-last step is for the user to select whether to permit transmission of "the packet data" to the mobile terminal, and the final step is to route "the packet data" to the mobile terminal when permission is granted. *Andersson* has no disclosure that the Internet Host or Sending Station takes any action to transmit packet data between the time that the mobile device authorizes receipt of the packet data, and the network infrastructure forwards the packet data to the mobile device, as recited in combination with the other claim elements. Stated another way, *Andersson* teaches that the network infrastructure receives, from the sending station, a transmission of the packet data that is ultimately forwarded/routed to the mobile terminal sending station, and does so <u>before</u> the mobile terminal is provided notice of the existence of the packet data.[2] Accordingly, *Andersson* discloses that the sending station initially transmits the

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[2]   Figures 2 and 3 of *Andersson* also clearly illustrates that the sending station (e.g., Internet Host) that originates the packet data, necessarily transmits the packet before any communication with the mobile terminal occurs. In particular, and as illustrated in Figure 2, the only communication between the Internet Host and <u>any</u> other element in the system disclosed in *Andersson*, is the first sequential act 86, in which the Internet Host transmits the packet data as the first step in the process. Thereafter, the remaining acts take place between mobile terminal 14 and other elements of PLMN 18.

Similarly, Figure 3 illustrates a system in which the first step is for the network infrastructure to detect receipt of the packet data (step 164). Only thereafter is a selection made as to whether to permit transmission of the packet data (step 174) so that the packet data can be sent to the mobile receiving station (step 176). No intermediate step between steps 174 and 176 is disclosed where additional packet data is acquired, such that the only packet data sent to the mobile station is that initially acquired from the sending station in step 164, well before permission to receive the packet data was granted..

packet data before the wireless mobile communication station has determined that packet data reception from the originator is desired, rather than only after such determination, as claimed in combination with the other claim elements.

II. Rejections Under 35 U.S.C. § 101

As noted above, claims 1-10, 13-22, 24 and 25 were rejected as being directed to non-statutory subject matter. Particularly in view of the amendments above, Applicant respectfully submits that this rejection is now moot.

In particular, in making the rejection, the Office Action appears to rely on the claims reciting methods which include acts that could be implemented by a processor executing computer-executable instructions, but without express recitation of such execution. (See Office Action, pp. 3-8). In particular, the Office contends that the claims lack substantial practical application since the method "is just a list of computer software instructions, which are not actually being performed." Applicant respectfully disagrees.

In particular, the claims clearly recite "methods" which, by definition, require affirmative actions to take place. In other words, there is no "method" if no actions take place. Moreover, when the claims are read in the context of Applicant's Specification, it is clear that there is no support for the assertion that the recited methods do not require affirmative actions and are merely lists of actions to take place. Indeed, the Office Action specifically notes that Applicant has indicated that objects of the present invention are achieved by the "methods" described in the application. (*See* Office Action, p. 4). Were the methods merely lists of actions to take place, the method could not achieve the objects described.[3]

Although not necessary, Applicant has nevertheless amended the claims to clarify what was already inherently within the claims, namely that each method step is being actively

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[3] Applicant also notes that the inquiry regarding 35 U.S.C. § 101 focuses on the end-result and not the particular steps taken to achieve the result. The result, as clearly identified in the above claims, is a selective, packet-data session between a wireless mobile device and a server which originates packet data. As described in greater detail in Applicant's specification, such a packet data session allows an originator to push messages to the wireless mobile device only when the user has determined he/she wants to see such messages. As noted by Deputy Commissioner John Love, "If the result has a real world practical application/use, then the test [for subject matter eligibility] has been satisfied." (Memorandum to Technology Center Directors. dated April 12, 2007, subject "Clarification of Interim Guidelines For Examination of Patent Applications for Subject Matter Eligibility") Transferring messages from a server to a client is a well-established practical use of wireless technology. Accordingly, the test for subject matter eligibility is satisfied.

performed by a corresponding computing system. Accordingly, a practical application, and a useful, concrete and tangible result, is clearly provided.

III.   Conclusion

In view of the foregoing, Applicants respectfully submit that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicants acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicants reserve the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicants specifically request that the Examiner provide references supporting the teachings officially noticed, as well as the required motivation or suggestion to combine the relied upon notice with the other art of record.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney by telephone at (801) 533-9800.

Dated this 16th day of October, 2007.

Respectfully submitted,

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